

REMARKS

Applicants acknowledge receipt of an Office Action dated June 10, 2009. Claims 1-9 and 11-19 are pending.

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Allowable Subject Matter

Applicants acknowledge the Office's indication that claims 11-19 are allowable.

Rejection Under 35 U.S.C. § 103

Claims 1-4 and 6-10

On pages 3-5 of the Office Action, the Office has rejected claims 1-4 and 6-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 4,714,693 to Targos (hereafter "Targos") in view of Training Papers Spray Drying BUCHI Labortechnik AG (hereafter "Buchi"), and U.S. Patent 7,022,642 to Yamamoto (hereafter "Yamamoto"). Applicants respectfully traverse this rejection for at least the reasons set forth below.

As a preliminary matter, Applicants note that Yamamoto cannot be used as prior art in a §103(a) rejection against the present application in view of 35 U.S.C. §103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the present case, the Yamamoto application is only available as prior art against the present application under §102(e). Furthermore, the subject matter of U.S. Patent 7,022,642 and the claimed invention were, at the time the claimed invention was made, owned by Nissan Motor Co., Ltd. or subject to an obligation of assignment to Nissan Motor Co., Ltd. Applicants submit herewith APPENDIX A which includes Exhibits A and B to establish common ownership between U.S. Patent 7,022,642 and the claimed invention as described above.

Furthermore, Applicants submit that Targos and Buchi, separately or in combination, fail to teach or suggest “reducing the noble metal precursor to a noble metal particle by adding a reducing agent to the reverse micellar solution” as recited in claim 1. Claims 2-4 and 6-9 depend from claim 1.

Targos teaches a method of making a catalyst in which metal compounds on a support are reduced while on the support surface by contact with flowing hydrogen. See Targos at col. 6, lines 50-56. However, before any reduction step occurs in the method of Targos, the support material is separated from the “impregnant” solution and then dried with air, purged with helium, and oxidized with air. See Targos at col. 6 lines 35-56. Thus, Targos does not disclose or suggest adding a reducing agent to a reverse micellar solution.

Buchi fails to remedy the deficiencies of Targos discussed above. For example, Buchi fails to teach or suggest a catalyst producing method comprising the step of “reducing the noble metal precursor to a noble metal particle by adding a reducing agent to the reverse micellar solution.” Buchi instead appears to be a training manual for spray drying processes which does not provide detail for reducing a noble metal precursor.

With respect to Yamamoto, Applicants submit that the Office has inadvertently, but improperly, relied upon subject matter which was commonly owned at the time of the present invention. The present application is the U.S. National phase application of PCT/JP2004/018338 filed December 2, 2004. Therefore, the claimed invention is entitled to at least the December 2, 2004 filing date of its PCT counterpart.

Thus, Applicants submit that for at least the reasons stated above and because §103(c) prohibits a §103(a) rejection in the presently claimed invention over Targos in view of Buchi and Yamamoto, claims 1-4 and 6-10 are allowable. Applicant respectfully requests a withdrawal of the rejections.

Claim 5

On pages 5-6 of the Office Action, the Office has rejected claim 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Targos in view Buchi and Yamamoto, and further in view of U.S. Patent 6,413,489 to Ying *et al.* (hereafter “Ying”). Applicants respectfully traverse this rejection for at least the reasons set forth below.

Ying fails to remedy the deficiencies of Targos in view of Buchi discussed above in regard to independent claim 1, from which claim 5 depends. Furthermore, Yamamoto cannot be used as prior art in a §103(a) rejection against the present application in view of 35 U.S.C. §103(c) as discussed above. For at least these reasons Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION


Applicants submit that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 9/10/09

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

Paul D. Strain
Attorney for Applicant
Registration No. 47,369

APPENDIX A